

REMARKS**Summary of the Office Action**

This Amendment responds to the Office Action mailed on April 30, 2009 (“Office Action”). Claims 1-16 and new claims 17-27 are pending in this application. Claims 2-12 are withdrawn by restriction. Claims 1 and 13-16 stand rejected. Claim 13 has been amended for clarification purposes. Accordingly, reconsideration of claims 1 and 13-16 and examination of new claims 17-27 is respectfully requested. No new matter has been added as the amendments are believed to be fully supported by the specification, claims and drawings as originally filed.

Rejections to the Claims Under 35 U.S.C. § 102(b)

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,763,167 to Watanabe et al. (“Watanabe”). The rejection identifies guide member 302 of Watanabe as a punching device recited by claim 1. Guide member 302 is neither a punching device nor a stapler, and thus the rejection fails to make a prima facie case of anticipation. Accordingly, Applicant submits that the rejection under 35 U.S.C. § 102(b) has been overcome and should be withdrawn.

Rejections to the Claims Under 35 U.S.C. § 103(a)

Claims 13-16 stand rejected under 35 U.S.C. § 103(a) as obvious over Watanabe in view of one or both of U.S. Patent No. 6,361,036 to Nakazawa (“Nakazawa”) and U.S. Published Application No. 2005/0155474 to Okamoto et al (“Okamoto et al.”). Applicant traverses.

As acknowledged in the rejection, Watanabe lacks a “sheet positioning mechanism” as recited by claims 13-16. For the reasons below, the rejection of claims 13-16 under 35 U.S.C. § 103(a) fails to remedy the deficiency of Watanabe and separately fails to articulate a prima facie case of obviousness.

Rejections on Obviousness Cannot Be Sustained With Mere Conclusory Statements

The rejection does not articulate a clear rationale for supporting the obviousness rejection. The rejection appears to rely on rationale “G” of MPEP 2143 which provides for combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching or motivation to do so. The rejection fails to identify each and every limitation in the applied references. It relies on “Official notice” that the claimed features are allegedly “old and well known,” without support from the record. Thus, the rejection fails to clearly articulate the basis for why the claimed invention would have been obvious. Instead, the rejection is vague because it does not identify each of the factual findings that are necessary to underpin the conclusion of obviousness. Further the rejection fails to consider all the words in claims 13-16 in assessing the patentability of those claims. *See* MPEP §2143.03. Accordingly, the rejection lacks adequate factual support and is conclusory. *See* MPEP §2142, Establishing A Prima Facie Case of Obviousness (quoting the Federal Circuit “rejections on obviousness cannot be sustained with mere conclusory statements”).

No Motivation to Combine Prior Art References Because The Opposing Principles of Operation Teach Away From the Combination and Would Render The Prior Art Unsuitable for Its Intended Purpose

No motivation can exist to combine the teachings of Nakazawa or Okamo with the disclosure of Watanabe because the three punching apparatuses operate on opposing principles, and any proposed combination to remedy the deficiency of Watanabe would render the prior art unsatisfactory for its intended purpose (e.g., punching sheets of paper).

Nakazawa is directed to a sheet finisher that executes continuous punching on a sheet while maintaining the conveyance speed of the sheet ejected from the image forming apparatus. Nakazawa, Abstract, lines 1-4. In particular, when sheet P is detected by sheet sensor 14, the drive control unit 80 switches the conveyance speed of the second punching conveyance roller 302 from the speed V1 into the speed V2 higher than V1. *Id.* at 5:60-66. Since the sheet conveyance speed of the first punching conveyance roller 303 is the speed V1,

the loop R of the sheet P is formed between the first punching conveyance roller and the second punching conveyance roller. *Id.* at 6:1-6. The punching unit 301 is driven to punch the sheet within a time until the loop is dissolved. *Id.* at 6:13-15. Because the sheet P is continuously conveyed by the first conveyance roller 303, the loop is dissolved with the passage of time, and the sheet P can be punched in continuous coverage. *Id.* 6:17-20. A major object of the sheet finisher disclosed by Nakazawa is to provide a sheet puncher that executes a punching to a sheet ejected from an image forming apparatus while maintaining the conveyance speed of the ejected sheet. *Id.* at 2:11-15.

Okamoto et al discloses a punching unit comprised of punches and dies that synchronizes the sheet speed with the punch speed to execute the punching process without stopping the sheet from being conveyed. Okamoto et al. at ¶007. The offset distance between the center of each hole and the trailing end of the sheet is controlled by using the sheet end as a reference and driving the punch at a predetermined period of time based on paper size and conveyance speed. *Id.* at ¶72-82.

By contrast, Watanabe discloses a punching unit that stacks all the sheets to be punched on a guide member 323, before lowering a punching device to punch stationary sheets. Watanabe at 10:10-16. After punching the stationary stack of sheets, the punching device 322 returns to the upper original position and the stopper 324 is lifted to form a transport path. *Id.* Then the feed roller 325 is lowered to the broken line position in contact with the sheets, and is rotated to feed the sheets from the top. *Id.* at 10:16-20.

Accordingly, the punching apparatuses of Watanabe and Nakazawa or Okamoto et al operate on opposing principles, and thus there would be no motivation to combine the stationary sheet punching teaching of Watanabe with the continuous sheet punching techniques of Nakazawa or Okamoto et al. Moreover, the disclosed principles of operation relating to stationary and continuous sheet punching are opposite, and thus the proposed combination would render the prior art unsatisfactory for its intended purpose (e.g., the stationary or continuous punching of a series of paper sheets).

Nakazawa and Okamo Fail to Remedy the Deficiency of Watanabe

In view of the above, Nakazawa and Okamoto et al alone or in any combination neither disclose nor suggest a “sheet positioning mechanism” as recited by claims 13-16, and thus cannot remedy the deficiency of Watanabe.

The Assertion of Official Notice Is Not Adequate to Support the Rejection

Applicant traverses the “Official Notice” relied upon in the rejection of claims 13-16 under 35 U.S.C. § 103(a), which alleges that the sheet positioning structure recited by claims 13-16 is “old and well known.”

Neither Nakazawa nor Okamoto et al. disclose or suggest each and every limitation of the “sheet positioning mechanism” of claims 13-16. Nor do these references disclose or suggest the need for a positional deviation correction capability as recited by claims 13-16. Hence, the justification for taking Official notice that the “sheet positioning mechanism” recited by claims 13-16 is “old and well known” is a conclusory statement, which is based on vague and unsupported allegations. *See, In re Zurko*, 59 USPQ2D 1693, 1697.

The alleged noticed “facts”, therefore, are insufficient to render each and every missing element obvious. Alternatively, the references do not support a “notice of facts” sufficient to meet every limitation of claims 13-16 because such facts are not capable of instant and unquestionable demonstration as to defy dispute, in which case the alleged noticed “facts” fail to meet the relevant legal standard for their establishment and use. *See MPEP 2144.03. See, In re Ahlert and Kruger*, 165 USPQ 418, 420. Thus, the alleged noticed “facts” are insufficient to underpin a conclusion of obviousness.

Accordingly, the rejection of claims 13-16 under 35 U.S.C. § 103(a) is flawed because there is neither substantial evidence of record nor a proper “notice of facts” to underpin the rejection.

The Rejection Fails to Resolve Two Factual Inquiries of *Graham v. John Deere Co.*

The rejection of claims 13-16 under 35 U.S.C. § 103(a) fails to identify and address (1) the level of ordinary skill in the prior art, and (2) the differences between the claimed invention and the prior art as required by *Graham v. John Deere Co.*, 383 US 1, 14, 148 USPQ 459, 465 (1966).

First, the rejection is silent about the level of ordinary skill in the prior art. Second, the rejection fails to consider all the words in claims 13-16, and thus all the limitations of these claims were not considered in rejecting the claims as obvious. *See*, MPEP §2143.03. Instead, the rejection attempts to distill the claims down to a “gist” (e.g., “a sheet positioning structure”) and disregards the requirement of analyzing the subject matter “as a whole.”

Accordingly, the rejection of claims 13-17 under 35 U.S.C. § 103(a) fails to consider the claimed invention and the prior art references “as a whole” (*See*, MPEP 2141.02) and separately fails to resolve the level of ordinary skill in the art upon which the rejection is based. For these reasons, the rejection of claims 13-16 under 35 U.S.C. § 103(a) fails to address and resolve controlling factual inquiries that are required by *Graham v. John Deere Co.* *See* MPEP 2141 II.

Consequently, the rejection of claims 13-16 under 35 U.S.C. § 103(a) fails to establish a prima facie case of obviousness and should be withdrawn.

New Claims

Dependent Claims 17 and 18

New claims 17 and 18 ultimately depend from claim 1 and recite additional features of the paper sheet treating device of claim 1, and thus are believed patentable over Watanabe, Nakazawa and Okamoto et al. for at least the same reasons as claim 1 as well as the additional features they recite.

Independent Claim 19

New claim 19 recites the subject matter of original claim 13 rewritten in independent form, along with additional features of “closing type fence” disclosed by applicant in the

specification and drawings as originally filed, and thus is believed to be patentable over Watanabe, Nakazawa and Okamoto et al. for at least the same reasons as claim 13 as well as the additional features it recites.

Dependent Claims 20 and 22

New claims 20-22 depend or ultimately depend from claim 19 and recite additional features of the paper sheet treating device of claim 19, and thus are believed patentable over Watanabe, Nakazawa and Okamoto et al. for at least the same reasons as claim 19 as well as the additional features they recite.

Independent Claim 23

New claim 23 is directed to a sheet treating device for performing a treatment on a sheet of paper that includes a punching unit which comprises a positional deviation storage unit, a sheet positioning mechanism, and a control unit. Claim 23 is believed to be patentable over Watanabe, Nakazawa and Okamoto et al. for the particular features it recites.

Dependent Claims 24-27

New claims 24-27 depend or ultimately depend from claim 23 and recite additional features of the sheet treating device of claim 23, and thus are believed patentable over Watanabe, Nakazawa and Okamoto et al. for at least the same reasons as claim 23 as well as for the additional features they recite.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance, and thus request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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